

R E M A R K S

This Amendment is submitted simultaneously with filing of the Request for Continuing Examination.

In the last Office Action Claims 1, 3, 9, 11-13 and 17 were rejected under 35 USC 102(b) as being anticipated by the patent to Knouse.

Claims 2 and 4 are rejected under 35 USC 102(b) as being anticipated by or as being obvious over the patent to Knouse.

Claims 7 and 8 are rejected under 35 USC 103(a) as being obvious over the patent to Knouse.

Claims 1, 3, 9 and 10 are rejected under 35 USC 103(a) as being unpatentable over the U.S. patent to Nalley in view of the patent to Knouse.

Also, Claims 15-17 are rejected under 35 USC 112.

Turning now first to the Examiners grounds for rejection of the Claims 15 and 16 for formal reasons. It is respectfully submitted that the Examiners analysis of these claims is not correct. The Examiner indicated that it was not clear how an angle, which is virtual or imaginary, can perform a guiding

function, since no structure was set forth to perform such a function. It is respectfully submitted that “an angle” defined in Claim 15 is not virtual or imaginary, but is a structural element which is identified as an “angle.” The flexible connecting element is flexibly guided on this structural element formed as the angle.

It is therefore believed that the Examiners grounds for formal rejection of Claims 15-17 should be considered as no longer tenable and should be withdrawn.

Turning now to the Examiners rejection of the claims over the art, in the Examiner’s opinion the references disclosed a flexible connecting element since a connecting element in the prior art is inherently flexible to at least some extent.

Applicants have to respectfully disagree with this position for the following reasons. Based on Figure 2 of the Knouse reference, bar or link 56 is not made of “sheet” metal (the preferred material for the flexible connecting element). Applicants note how the thickness of bar 56 is approximately two or more times the thickness of the slots in the screw heads (the screw heads are located between pivot point 47 and switch 39 in Figure 2) while the length and width dimensions are even greater than its thickness. A person of ordinary skill in the art would appreciate that the working end of a screw driver is normally not

considered to be "inherently flexible." Since the bar or link 56 is considerably thicker than the working end of a screw driver, there appears to be no basis for the assumption that this structural configuration imparts this bar with flexibility. The question is not whether the bar or link 56 could have this thickness and still be flexible, but whether this is inherent to the disclosure-and it is not.

Furthermore, based on the manner in which the bar or link 56 is intended to function it is desirable for it not to be flexible. It comprises a link between pivot points which anchor the two switch triggers 30 and 32. If this part were flexible along its length, then the two switch triggers would not be tightly coupled. For example, if there were slack in the link 52, then the depressing switch trigger 32 would not effectively actuate the tool, or at least not do so in a similar manner as switch trigger 30. Based on this construction, it would not be surprising to one of ordinary skill in the art if the bar or link 56 were constructed of steel or another hard metal.

Thus, the Knouse reference does not teach the aforementioned new feature of the present invention. The Nalley reference also does not disclose anything related to this feature.

The Examiner rejected the original claims as being anticipated. In connection with the anticipation rejection, it is believed to be advisable to cite the

decision In Re Lindenman Maschinenfabrik GmbH v. American Hoist & Derrick Co., 221 USPQ 481, 485 (Fed. Cir 1984) in which it was stated:

“Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim.”

Definitely, the references do not disclose each and every element of the present invention as now defined in Claim 1.

The claims were also rejected by the Examiner as being obvious under 35 USC 103. In connection with this, it is respectfully submitted that it would not be sufficient to combine the references to arrive at the applicant's invention since the reference did not provide any hint or suggestion for the new features of the present invention as defined in Claim 1. In order to arrive at the applicant's invention from the references in their combination, the references have to be fundamentally modified by including into them the new features of the present invention which are now defined in Claim 1. However, it is known that in order to arrive at a claimed invention, by modifying the references the cited art must itself contain a suggestion for such a modification.

This principle has been consistently upheld by the U.S. Court of Customs and Patent Appeals which, for example, held in its decision In Re Randol and Redford (165 USPQ 586) that:

Prior patents are references only for what they clearly disclose or suggest, it is not a proper use of a patent as a reference to modify its structure to one which prior art references do not suggest.

Therefore, it is believed that Claim 1 should be considered as patentably distinguishing over the art and should be allowed.

As for Claims 14-16, the Examiner has taken official notice indicating that “there are various well known configurations for connecting tandem switches” and that “the structure set forth in the subject claims switch on various ones of these known configurations.” If the Examiner’s assertion were true, then these “known configurations” should be readily demonstrable in a prior art reference. They are not structures which are “capable of instant and unquestionable” demonstration as being well known. According to MPEP §2144, part A, such notice should be “rare when an application is under final rejection.” The Examiner did not cite in any Office Actions any prior art related to the limitations defined in Claims 14-16. It is respectfully submitted that if the applicant adequately traverses the Examiners assertion of official notice, the Examiner must provide documentary evidence in the next Office Action if the rejection is to be maintained (see MPEP §2144.04, part C).

It is therefore believed that Claims 14-16 should be considered as patentably distinguishing over the art and should be allowed.

The same is true with respect to Claims 18-21, whose features are not disclosed in the references and could not be derived on them as a matter of obviousness. Claims 18-21 should be allowed as well.

With the present Amendment applicants also corrected Figures 4 and 5 to identify the ramp or slanted surface 118.

In view of the above presented remarks and amendments, it is respectfully submitted that the present application should be allowed, and such action is earnestly solicited.

Should the Examiner require or consider it advisable that the specification, claims and/or drawings be further amended or corrected in formal respects in order to place this case in condition for final allowance, then it is respectfully requested that such amendments or corrections be carried out by Examiner's Amendment, and the case be passed to issue. Alternatively, should the Examiner feel that a personal discussion might be helpful in advancing this case to allowance; he is invited to telephone the undersigned (at 631-549-4700).

Respectfully submitted,



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